

REMARKS

Interview with Examiner

Applicants thank the Examiner for the telephone interview conducted on February 23, 2011. Applicants believe that the interview was helpful in advancing the prosecution of this application. A Statement of Substance of Interview is being submitted concurrently herewith.

Rejections over Koyanagi in view of Wyatt and over Kamayachi in view of Wyatt

On page 2 of the Office Action, in paragraph 4, claims 3, 12, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyanagi et al. (WO 03/072634, wherein the citations are from the English equivalent document US Pg-Pub 2005/0153530) in view of Wyatt et al. (US Pg-Pub 2003/0118946). Further, on page 4 of the Office Action, in paragraph 5, claims 3, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamayachi et al. (US Patent 4,943,516) in view of Wyatt et al. (US Pg-Pub 2003/0118946).

Applicants respectfully submit that the present invention is not obvious over the cited art, and request that the Examiner reconsider and withdraw these rejections in view of the following remarks.

Initially, Applicants submit that with respect to the cited references, none of the references discloses or suggests the problem to be solved by the present invention that a pigment tends to remain when removing a photosensitive composition containing a pigment, and they did not recognize the problem newly generated when using a photosensitive composition containing a pigment. The composition of the remover, i.e., the content of each component, is important in order to solve this problem. However, Applicants believe that the Examiner's opinion is based on a view that the cleanability does not depend on the presence or absence of a pigment.

Applicants note that the reason why the experimental evidence was submitted was to show that cleanability for a photosensitive composition containing a pigment varies with the number of carbon atom of aromatic hydrocarbon and that the content of each component is important.

Thus, Applicants respectfully request that the Examiner take into consideration that cleanability for a photosensitive composition containing a pigment depends on the number of carbon atoms of the aromatic hydrocarbon as shown in the Declaration and that the cited references do not disclose or suggest that the composition of the present invention is effective for removing a photosensitive composition containing a pigment. In this regard, Applicants note that the number of carbon atoms of aromatic hydrocarbon recited in claims is not 12, and that aromatic hydrocarbons having different number of carbon atoms have different cleanability for a photosensitive composition containing a pigment.

In this regard, it is submitted that the present invention is not obvious over the cited art based on the PTO's own "Examination Guidelines Update: Developments in the Obviousness Inquiry after *KSR v. Teleflex*" effective in September, 2010.

In particular, based on the *In re Omeprazole Patent Litigation*, 536 F.3d 1361 (2008), the PTO has indicated that even where a general method that could have been applied to make the claimed product was known and was within the level of skill of an artisan, the claim may nevertheless be non-obvious if the problem which had suggested use of the method had been previously unknown. As discussed above, the cited art does not teach or suggest the problem addressed by the present invention (i.e., that a pigment tends to remain when removing a photosensitive composition containing a pigment), so even if general method used to solve the

problem was known (which Applicants do not concede to be the case), the claimed invention still is not obvious.

Turning now to the cited references in particular, Applicants have the following comments.

Koyanagi et al. (WO 03/072634) relate to a photosensitive resin composition, and disclose a variety of solvents as examples of a developer used in the development. However, Koyanagi et al. do not disclose or suggest any specific composition of a mixture of these components as in the present invention.

Also, Kamayachi et al. (USP 4,943,516) relate to a photosensitive thermosetting resin composition and a method of forming solder resist pattern, and disclose a variety of solvents as examples of a developing solution. However, Kamayachi et al. do not disclose or suggest any specific composition of a mixture of these components as in the present invention.

On the other hand, Wyatt et al. (US 2003/0118946 A1) disclose a composition containing 20 wt % of diisopropylbenzene as a developing solution comprising diisopropylbenzene having 12 carbon atoms as an essential component.

The Examiner has consistently maintained the position that the present invention is obvious from the combination of Koyanagi et al. or Kamayachi et al. with Wyatt et al. since Wyatt et al. disclose a composition containing 20 wt % of diisopropylbenzene, even though Koyanagi et al. or Kamayachi et al. fail to disclose the particular components that are combined to prepare a developer at the ratio recited in the claims of the present application.

Applicants argued that diisopropylbenzene is a C₁₂ aromatic hydrocarbon and not "basically C₉ or C₁₀-based" as recited in claims 3 and 19 of the present application, and

submitted experimental data showing that aromatic hydrocarbons having different number of carbon atoms have different cleanability for a photosensitive composition containing a pigment.

Applicants further submitted experimental data showing that a composition which is within the scope of claim 3 of the present application has a superior cleanability to the composition of Example 4 of Wyatt et al.

However, the Examiner has maintained the rejection since the Declaration under 37 CFR 1.132 shows only one solvent mixture within the scope of claim 3 and the evidence presented in the Declaration is not commensurate with the scope of claim 3, and therefore the Declaration under 37 CFR 1.132 is allegedly not sufficient to overcome the rejection.

The reason why Applicants submitted the experimental data was to explain to the Examiner that cleanability for a photosensitive composition containing a pigment varies with the number of carbon atoms of aromatic hydrocarbon and that the content of each component is important.

With respect to the issue of commensurateness, Applicants submit that the invention embodiment shown in the last Declaration is not the only experimental evidence representing the present invention. Rather, the present application itself contains a number of invention embodiments, as can be seen from Table 1 in the present application. In particular, Examples 9, 10, 11, 12, 13, and 14 are within the scope of the present claims. In this regard, it is submitted that besides Solfine-TM and SW 1500 tested in the Declaration, Solvesso 100, 1,2,4-trimethylbenzene, and cumene are other basically C9 or C10-based aromatic hydrocarbons that have been tested (see Examples 9, 12, 13 and 14 (Examples 10 and 11 used Solfine-TM, which was used in the Declaration)). Further, Applicants submit that besides propylene glycol monomethyl ether and cyclohexanone tested in the Declaration, propylene glycol monomethyl

ether acetate, butyl acetate, and methyl 3-methoxypropionate are other solvents other than aprotic solvents that have been tested (see Examples 9, 10, 11 and 14 (Examples 12 and 13 used propylene glycol monomethyl ether and cyclohexanone, which were used in the Declaration)). Accordingly, it is submitted that the experimentation of record is sufficient to be commensurate in scope with the claims.

Further, as discussed above, none of the references discloses or suggests the problem to be solved by the present invention that a pigment tends to remain when removing a photosensitive composition containing a pigment, and they did not recognize the problem generated newly when using a photosensitive composition containing a pigment. The composition of the remover, i.e., the contents of each component, is important in order to solve this problem. Applicants believe the Examiner's opinion is based on a view that the cleanability does not depend on the presence or absence of a pigment, and is based on mere hindsight.

Thus, Applicants submit that the present invention is not obvious over the cited art, and withdrawal of these rejections is respectfully requested.

Rejection over Kamayachi in view of Wyatt and further in view of Dhillon

On page 6 of the Office Action, in paragraph 6, claims 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamayachi et al. (US Patent 4,943,516) in view of Wyatt et al. (US Pg-Pub 2003/0118946) as applied to claim 3 and in further view of Dhillon (US Patent 4,822,723).

In response, Applicants note that claim 6 depends on claim 3 and that claim 18 depends on claim 6. Therefore, Applicants submit that since the rejection of claim 3 is overcome as discussed above, the rejection of claims 6 and 18 is also overcome on at least the same basis,

since it is submitted that Dhillon does not make up for the deficiencies of the other art as discussed above.

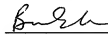
Thus, Applicants submit that the present invention is not obvious over the cited art, and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Bruce E. Kramer
Registration No. 33,725

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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